

Application No.: 09/002,011
Attorney Docket No.: UA.314RE

REMARKS

Defective Declaration

The Examiner has indicated that the reissue oath/declaration filed with this application is defective because the error relied upon to support the reissue application is not an error upon which a reissue can be based. Particularly, the Examiner contends that, because polymeric film claims were cancelled during the prosecution of the original patent, and Applicant elected to prosecute only claims directed toward a glove, 35 U.S.C. § 251 cannot be used to circumvent other statutory requirements, *e.g.*, the copendency requirement of 35 U.S.C. § 120 for filing a divisional or continuation application. The Examiner also rejects claims 1-34 on these grounds, *i.e.* as being based upon a defective reissue declaration.

In response, Applicants note that it is not the intent or result of their actions to circumvent statutory copendency requirements. Applicants' files, maintained during the prosecution history of the original patent, show that a restriction requirement was never levied by the Examiner, and, thus, Applicants never made an election to prosecute only claims directed toward a glove. Notably, the polymeric film claims were not canceled to overcome a prior art rejection. Indeed, from the prosecution history of the original patent, it is not clear why Applicants canceled the polymeric film claims except, as indicated in the reissue application, Applicants failed to appreciate that the cancellation of those claims would limit their scope of protection to gloves. Quoting from the Reissue Declaration and Power of Attorney:

[Applicants] recognized that an error existed in the issued patent because [they] had claimed less than [t]hey had a right to claim in the patents. Specifically, [they] noticed that the issued patent contained only claims directed to a "medical glove" when, in fact, the specification supports broader claims to a polymeric film and articles formed therefrom.

Thus, as indicated when filing, "[t]he error to be corrected by the present reissue application stems from [Applicants'] failure to appreciate the scope of the claims ultimately allowed."¹ This error causes the patent to be partly inoperative by reason of the patentees claiming less than they had a right to claim in the patent, and this error is a proper basis for reissue under the patent statutes and rules. Reconsideration of claims 1-34 is therefore respectfully requested.

¹See, Reissue Declaration and Power of Attorney

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Recapture Rejection

The Examiner has rejected claims 23-31 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent on which the present reissue is based. Quoting *Ball Corp. v. United States*,² the Examiner notes that "the recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application." Comparing the polymeric film claims 23-31 of the reissue application to the cancelled polymeric film claims 14-16 of the original application, the Examiner found that the reissue polymeric film claims are broader than the cancelled claims with respect to the limitation of the film having "a three dimensional network" of chopped fibers. Continuing, the Examiner found that the reissue film claim 23 is narrower in another aspect, since claim 23 recites the chopped fibers as being "randomly" dispersed within the film. Thus, the Examiner found that the reissue claim is broader than the cancelled claims in some aspects, but narrower in others, and applies the recapture rule by contending that both the broadening and narrowing aspects were germane to prior art rejections.

Relying upon *In re Clement*,³ Applicants respectfully disagree. The Examiner's analysis disregards established case law and patent examining procedure. Particularly, [t]he first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims.⁴ Thereafter, in step two, the broader aspects of the reissue claims are considered to determine whether they relate to surrender subject matter.⁵ The Examiner has failed to follow these steps in the analysis.

Comparing independent reissue claim 23 with the broadest and most similar claim of the patent, which is patent claim 16, the only aspect in which reissue claims 23-31 are

²221 U.S.P.Q. 289, 295 (Fed. Cir. 1984)

³45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997)

⁴See, MPEP 1412.02, citing *In re Clement*, 45 U.S.P.Q.2d at 1164

⁵*Id.*

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broader than the patent claims is in the preamble recitation of a "polymeric film" rather than the recitation of a "medical glove." This completes the analysis for step one.

As to step two, in order to conclude that an Applicant surrendered particular subject matter, the prosecution history of the patent must be reviewed for arguments or amendments **made in an effort to overcome a prior art rejection.**⁶ Furthermore, "the recapture rule does not apply in the absence of evidence that the Applicant's amendment was 'an admission' that the scope of the claim was not in fact patentable."⁷ In the present case, there is no indication that Applicants ever canceled original polymeric film claims 14-16 in an effort to overcome a prior art rejection, and Applicant's actions never rose to the level of an admission that these claims were not patentable, especially in light of the fact that Applicants asked for cancellation without prejudice or disclaimer. Therefore, following the precedent set by the Federal Circuit in *Seattle Box Co.*⁸, the Examiner cannot apply the recapture rule in the absence of evidence that the Applicants "amendment . . . was in any sense an admission that the scope of [t]he claim was not patentable." Indeed, inasmuch as issued claim 16 is identical to reissue claim 23 in all aspects but the preamble recitation, Applicants' cancellation of claims 14-16 did not rise to an admission that those claims were unpatentable; although it does rise to the level of being an error upon which reissue may be granted, particularly, an error in appreciating the scope of protection to which Applicants were entitled.

Moreover, the facts of the present case do not satisfy the second step of the proper analysis set forth above, and the comparison between Applicants' cancelled polymeric film claims and the submitted reissue polymeric film claims need not be addressed. As set forth in *Clement*⁹, comparing the reissue claim with the cancelled claim is only necessary when there has been a determination that an Applicant has surrendered the subject matter of the cancelled claim. Applicants' have established that the cancellation of claims 14-16 in the

⁶*Id.* (emphasis added)

⁷*Id.* (citing *Seattle Box Co. v. Industrial Crating & Packaging, Inc.*, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984))

⁸221 U.S.P.Q. at 574

⁹*See, Clement*, at 1164

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original application was not made in an effort to overcome prior art rejections. Therefore, Applicants have not surrendered the subject matter of the cancelled claims, and comparing the reissue claim with a cancelled claim is an unnecessary and improper examining procedure. Applicants respectfully request reconsideration of the Examiner's rejection.

Rejections under 35 U.S.C. § 102 and Related § 103 Rejections

The Examiner has rejected claims 16-18, 23-25, and 31-34 under 35 U.S.C. 102(e) as being anticipated by Bray *et al.* (6,048,379). According to the Examiner, Bray discloses a glove (col. 7, l. 10) that is made of at least one polymeric layer including chopped fibers (col. 9, l. 31) randomly dispersed therein, as set forth in Applicants' claim 16. The Examiner contends that these fibers reinforce and add strength to the polymeric layer and inherently function to create cut and puncture resistant gloves. The Examiner also finds that the polymeric material forms a film to the extent recited in Applicants' independent claims 23 and 32.

Applicants respectfully disagree with the Examiner, and seek reconsideration. First, Bray does not disclose a glove made of at least one polymeric layer, and, does not disclose any item made of at least one **polymeric layer** including fibers **randomly dispersed therein**. At Bray, col. 6, lines 40-50, the polymeric material is employed as a polymeric binder, and does not form at least one polymeric layer within the compositions disclosed. Particularly, at Bray, col. 10, lines 5-10, these "polymeric binders" are "material[s] that [are] used to provide cohesion between the high density metal powder and the fibers such that the integrity of the metal and the fiber is maintained." What Bray really teaches is the dispersion of fibers throughout a metal (e.g., tungsten), not a polymeric layer as required by each of Applicants' independent claims 16, 23, and 32. Thus, the Examiner's findings that the fibers reinforce and add strength to the polymeric layer and that the fibers inherently function to create cut and puncture resistance in a glove are incorrect inasmuch as they serve to add strength to metal powders. Additionally, any inherent ability that they may have to provide puncture resistance to a glove is, at best, mere speculation.

Thus, the Bray reference does not teach a polymeric layer including fibers that are randomly dispersed therein, and it cannot be used to anticipate claims 16-18, 23-25, and 31-34. Applicants respectfully request reconsideration of these claims.

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The Examiner has also rejected claims 19 and 26-30 as being unpatentable as obvious in light of Bray; however, each of these claims depend from a claim argued hereinabove as being allowed, and, therefore, reconsideration of these claims as being based on an allowable base claim is also respectfully requested.¹⁰

The Examiner has also rejected claims 23-25 and 32-34 under 35 U.S.C. 102(b) as being anticipated by Dolowy, Jr. *et al.* (4,259,112). As with Bray, the Examiner contends that Dolowy discloses a polymeric film having at least one polymeric layer that includes fibers randomly dispersed therein for reinforcing and adding strength to the polymeric layer and creating cut and puncture resistance. For reasons substantially similar to those set forth with respect to the Bray reference, Applicants again respectfully disagree.

Dolowy teaches fibers dispersed throughout a metal powder, wherein a polymeric material is employed as a binder. This binder material is ultimately removed and, thus, exists only in an intermediate step during the process for manufacturing the reinforced composites taught by Dolowy. Inasmuch as this polymeric binder material is ultimately removed, it is quite clear that Dolowy does not disclose that fibers reinforce and add strength to the polymeric layer, but rather discloses the fibers as a reinforcement for metal powder. Additionally, this intermediate in no way anticipates any of claims 23-25 or 32-34 because this intermediate is never taught as being a separate, useful article in and of itself, and therefore never teaches what is claimed.

The Examiner has also rejected claims 24-31 and 33-34 as being unpatentable as obvious over Dolowy; however, Applicants seek reconsideration inasmuch as these claims are based upon allowable claims as argued above.

The Examiner has rejected all pending claims under 35 U.S.C. 102(a) as being unpatentable over Darras *et al.* (WO92/20244) in view of Dolowy, Jr. *et al.* According to the Examiner, Darras discloses a glove having an elastomeric layer that contains whiskers

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For the record, Applicants note that, regarding claims 28 and 29, the Examiner has cited Table 2 in Bray to show that this reference discloses a tensile strength commensurate with those claims. However, Table 2 lists the properties of the binders only, not the composites being produced in Bray. Thus, the comparison is improper. Applicants fail to see how a table listing the properties of various binders can be used to reject as obvious claims that are directed toward a polymeric film having fibers therein. Likewise, as to elongation properties, the cited values from Table 2 in Bray are for binders only, and the composites disclosed in Bray come nowhere near to having the elongation properties as claimed (*see* Fig. 9 of Bray).

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or particulates randomly dispersed throughout for enhancing the glove's cut resistance. The Examiner found that Darras does not disclose the use of chopped fibers within the polymeric matrix; however, the Examiner relies on Dolowy to support the suggestion that whiskers, particles, and chopped fibers are equivalent means of reinforcing polymers. The Examiner claims it would have been obvious to one of ordinary skill in the art to use chopped fibers in place of the whiskers or particles of Darras in order to reinforce the elastomeric layer since (1) Dolowy discloses the equivalence of chopped fibers and whiskers or particles for their use in the polymeric composite art and (2) Dolowy specifically teaches the use of chopped fibers to reinforce a polymeric matrix.

As already indicated above, the Examiner has misconstrued the teachings of Dolowy, and Applicants respectfully disagree with the Examiner's position. Particularly, the Examiner is incorrect in the assertion that Dolowy discloses the equivalence of chopped fibers and whiskers for their use in the polymeric composite art and that Dolowy specifically teaches the use of chopped fibers to reinforce a polymeric matrix. Again, Dolowy does not teach the reinforcement of a polymeric matrix, polymeric layer, or any other polymeric or elastomeric material. Rather, Dolowy teaches the reinforcement of a metal matrix. Dolowy teaches the use of a polymeric material only as a binder. And, inasmuch as Dolowy teaches the ultimate removal of the polymeric binder, there is no motivation or incentive to combine Dolowy with Darras, which is a reference in which the polymeric material must ultimately remain present. It is well settled that the prior art relied upon must contain some suggestion or incentive that would motivate the skilled artisan to modify or combine references.¹¹ Here, there is no suggestion or incentive to combine the references cited because, while one reference teaches a polymeric matrix having embedded therein hard material whiskers (Darras), the other reference teaches the reinforcement of a metal matrix with fibers and teaches that any polymeric material that may be employed as a binder is to be ultimately removed from the reinforced metal matrix being produced (Dolowy). Thus, Dolowy and Darras cannot properly be combined, and, therefore the Examiner has not established a *prima facie* case of obviousness, and Applicants ask for reconsideration of this rejection.

¹¹See *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988)

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Applicants have added claims 35-42 in the present Response. Each of these claims depends from an allowable base claim as indicated above, and, therefore, are considered to be in condition for allowance. Additionally, each of these claims is allowable inasmuch as they recite a weight percentage of elastomeric/polymeric material that is neither anticipated nor rendered obvious by the prior art. Support for the subject matter within these claims can be found in the reissue specification at page 5 lines 42-49, page 6 lines 20-22, and in each of the tables provided in the Experimental Section.

In light of the foregoing, Applicants respectfully request that the Examiner reconsider the present reissue application. Particularly, Applicants ask that the Examiner affirm that the error relied upon to support the present reissue is proper and correctable through this process, and that the new claims introduced do not present an attempt to improperly recapture subject matter. Also, Applicants ask that the Examiner reconsider the prior art cited, and a Notice of Allowance of claims 1-34 is earnestly solicited. Should the Examiner wish to discuss any of the foregoing in greater detail, the undersigned would welcome a telephone call.

In the event a fee is required with the filing of this Response and the required fee is not enclosed or is deemed insufficient, the Assistant Commissioner of Patents and Trademarks is hereby authorized to withdraw the required funds from Deposit Account No. 18-0987.

Respectfully submitted,



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